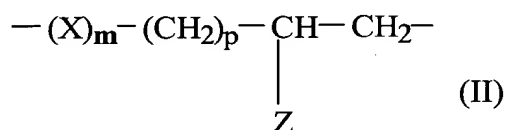


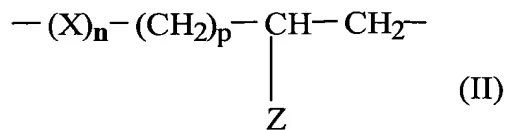
**REMARKS**

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, Claims 2 and 4 were amended to correct a typographical error. Specifically, Formula II was amended to read:



as opposed to the prior



This amendment was minor in nature and no new matter was added. Support therefor may be found, *inter alia*, in paragraph 0010, page 4 of the specification.

### **Summary**

As is correctly reflected in the Office Action Summary, Claims 1-31 are pending. Claims 5 and 14 have been withdrawn from consideration. Claims 1-4, 6-13, and 15-31 stand rejected. Acknowledgment has been made of a claim for foreign priority, and certified copies of all priority documents have been received.

### **Double-Patenting Rejections**

Turning now to the Official Action, Claims 1-31 were rejected under the judicially-created doctrine of obviousness-type double patenting over Claims 1-40 of U.S. Patent No. 6,251,373 to Candau ("Candau").

According to the Examiner, while "the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are directed to topically applicable sunscreen/cosmetic compositions for protecting human skin and/or hair against the damaging effects of UV radiation comprising at least one benzotriazole compounds and at least one bis-resorcinyltriazine compound in a cosmetically acceptable carrier." These rejections are respectfully traversed.

A double patenting rejection of the obviousness-type is analogous to a failure to meet the nonobviousness requirement of 35 U.S.C. § 103, except that the patent principally underlying the double patenting rejection is not considered prior art. *M.P.E.P.* § 804(II)(B)(1). Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. § 103(a) rejection, the factual

inquiries set forth in *Graham v. John Deere Co.* are employed when making an obviousness-type double patenting analysis. *Id.* These factual inquiries require that one: (A) determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (B) determine the differences between the scope and content of the patent claim and prior art as determined in (A) and the claim in the application at issue; (C) determine the level of ordinary skill in the pertinent art; and (D) evaluate any objective indicia of nonobviousness. *Id.* It is important to recall that "[w]hen considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art." *Id.*

The compositions of Claims 1-40 of Candau contain synergistically effective amounts of: (a) at least one benzotriazole compound of structural formula (I); (b) at least one bisresorcinyltriazine compound; and (c) at least one compound containing at least two benzoazolyl functional groups per molecule or at least one compound containing, per molecule, at least one benzodiazolyl functional group — formulated into a topically applicable, cosmetically acceptable vehicle, diluent, or carrier therefor. *See Candau, Column 22, Line 63 to Column 24, Line 23.*

Applicant's compositions of Claims 1-31, however, contain: (a) at least one benzotriazole compounds; and (b) at least one bis-resorcinyltriazine compound — formulated into a topically applicable cosmetically acceptable vehicle, diluent or carrier therefor wherein the composition maintains effective SPF and water remanence-enhancement.

Candau stresses that it is *the combination of three specific sunscreen compounds* that provides the synergistically active compositions that exhibit enhanced protection factors. *See Candau, Column 2, Lines 3-12; Column 17, Lines 62-67; Abstract.* Accordingly, Candau would motivate one of skill in the art to retain the combination of the three specific compounds for fear that failure to do so would terminate the enhanced protection. Moreover, Candau is silent as to water remanence-enhancement. This omission by Candau would prompt one of skill in the art to look elsewhere for guidance.

From the foregoing, it can be seen that Claims 1-40 of Candau fail to either motivate or suggest to one of skill in the art Applicant's effective SPF compositions which possess water remanence-enhancement. Applicant respectfully requests withdrawal of the obviousness-type double patenting rejection of instant Claims 1-31 over Claims 1-40 of Candau.

**35 U.S.C. § 112, Second Paragraph, Rejections**

Next, Claims 2, 4, and 6-9 were rejected under 35 U.S.C. §112, second paragraph, as purportedly indefinite. According to the Examiner, Claims 2, 4, and those that depend thereon, are confusing.

By the foregoing amendment, Claims 2 and 4 were amended to correct a typographical error. As noted by the Examiner, Formula II inadvertently failed to contain an "m." Instead, an "n" subscript had been used. Claims 2 and 4 now contain the "m" subscript and Applicant believes this minor correction has rendered the Examiner's

rejections moot. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph, rejections against Claims 2, 4, and those that depend thereon.

### **35 U.S.C. § 103(a) Rejections**

Finally, Claims 1-4, 6-13, and 15-31 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over either U.S. Patent No. 6,030,629 to Hansenne ("Hansenne") or U.S. Patent No. 6,171,579 to Allard et al. ("Allard") in view of European Patent No. 0 775 698 to Hüglin et al. ("Hüglin"). According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use bis-resorcinyltriazine of Huglin et al. for cosmetic sunscreen compositions of either Hansenne or Allard et al. for its art-recognized purpose." These rejections are respectfully traversed.

When applying 35 U.S.C. § 103, four tenets of patent law must be adhered to: (1) the claimed invention must be considered as a whole, (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination, (3) the references must be viewed without the benefit of impermissible hindsight vision, and (4) a reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141*, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986). Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference(s) must teach or suggest

all of the claim limitations. *See MPEP* § 2142. Applicants respectfully assert that these tests of obviousness have not been met in this case.

The compositions of Hansenne contain a synergistic association of UV filters comprising at least one silicone compound containing a benzotriazole functional group and at least one sulfonic sunscreensing derivative of benzimidazole C, wherein the ratio of these compounds ranges from 1/20 to 10/3. *See Hansenne, Column 10, Line 51 to Column 11, Line 57.* Hansenne stresses that *the combination of the two particular sunscreen active agents in certain well-defined proportions* that results in the enhanced sun protection. *See Hansenne, Column 2, Lines 8-17.* Hansenne is silent as to whether its compositions are water remanence-enhancing.

The compositions of Allard require at least one 1,3,5-triazine UV-sunscreensing compound of the specified formula and at least one benzotriazole substituted silicone UV-screensing compound which comprises at least one structural unit having formula (I). *See Allard, Column 11, Line 62 to Column 13, Line 23.* Like Hansenne, Allard stresses that *it is the combination of the two specific sunscreens* that results in the enhanced SPF. *See Allard, Column 1, Line 65 to Column 2, Line 5; Column 11, Lines 58-60.* Again like Hansenne, Allard is silent as to whether its compositions are water remanence-enhancing.

The compositions of Hüglin are cited by the Examiner to provide Applicant's elected bis-resorcinyltriazine compound. However, mere identification of each claimed element in the prior art is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Instead, there "must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the

invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 536 (Fed. Cir. 1998). Otherwise, sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. *Rouffet*, 149 F.3d at 1357.

Applicant maintains that there is no teaching or suggestion within the cited publications to pick and choose elements therefrom, as indicated by the Examiner.

As detailed above, both Hansenne and Allard stress that it is the combination of their particular components which synergistically produces enhanced SPF. One of skill in the art would therefor *not* be motivated to substitute any component thereof with the bis-resorcinyltriazine of Hüglin because to do so would likely ruin the SPF obtained absent such substitution.

Because there is no suggestion or motivation, outside Applicant's own disclosure, to modify and combine the cited publications as indicated by the Examiner, and because the cited publications are silent as to compositions which both maintain effective SPF-maintenance and possess water remanence-enhancement, Applicant maintains a *prima facie* case of obviousness has not been established.

In view of the foregoing, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejections against Claims 1-4, 6-13, and 15-31.

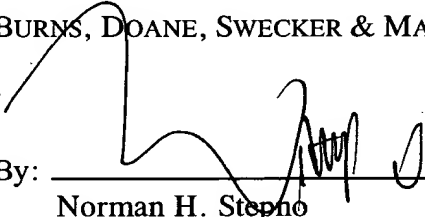
**CONCLUSION**

From the foregoing, further and favorable consideration in the form of a Notice of Allowance is respectfully requested and earnestly solicited.

In the event that there are any questions relating to this response, or the application in general, it would be greatly appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
Norman H. Stepho  
Registration No. 22,716

P.O. Box 1404  
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(703) 836-6620

Date: August 9, 2002

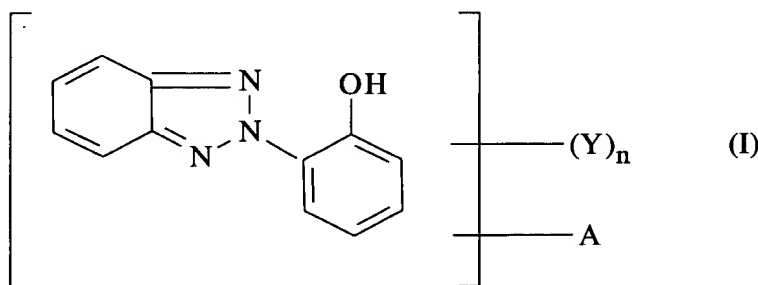




**Attachment to Reply and Amendment Dated**

**Marked-up Claims 2 and 4**

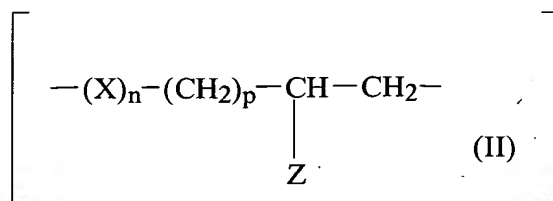
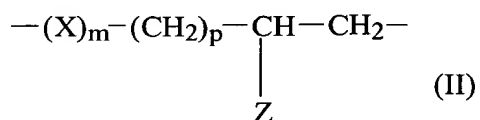
2. (Amended) A topically applicable sunscreen/cosmetic composition suited for the photoprotection of human skin and/or hair, comprising an effective SPF-maintaining and water remanence-enhancing amount of combinatory immixture of (a) at least one benzotriazole first sunscreen compound having the structural formula (I):



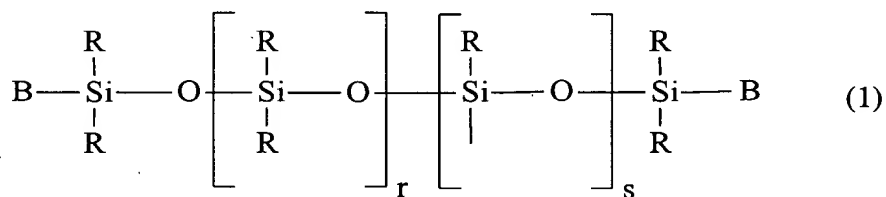
in which A is a hydrogen atom or a divalent radical -L-W-;  $\underline{n}$  is 1, 2, or 3; the radicals Y, which may be identical or different, are each a C<sub>1</sub>-C<sub>10</sub> alkyl radical, a halogen atom, a C<sub>1</sub>-C<sub>10</sub> alkoxy radical or a sulfonic group, with the proviso that, in the latter instance, two adjacent groups Y on the same aromatic nucleus can together form an alkylidenedioxy group in which the alkylidene moiety has 1 or 2 carbon atoms and with the further proviso that the radicals Y are other than a sulfonic group when A is other than a hydrogen atom; L is a divalent radical having the formula (II) below:

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**Marked-up Claims 2 and 4**



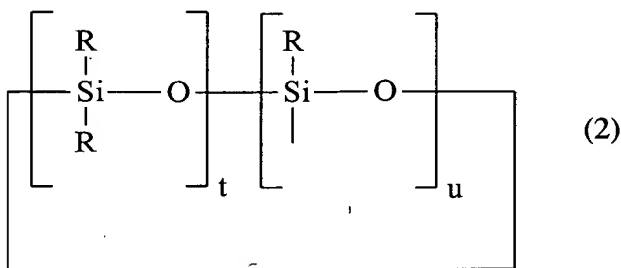
in which X is O or NH; Z is a hydrogen atom or a C<sub>1</sub>-C<sub>4</sub> alkyl radical; n is an integer ranging from 0 to 3, inclusive; m is 0 or 1; p is an integer ranging from 1 to 10, inclusive; W is a radical of formula (1), (2) or (3) below:



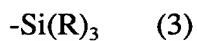
or

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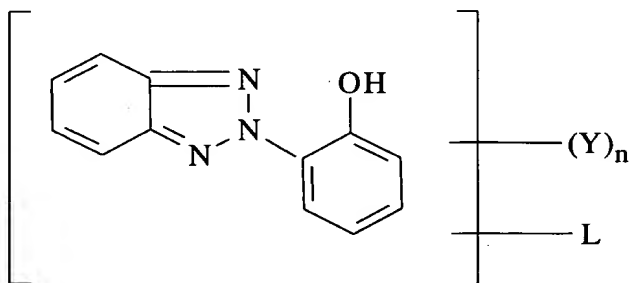
**Marked-up Claims 2 and 4**



or



in which the radicals R, which may be identical or different, are each a C<sub>1</sub>-C<sub>10</sub> alkyl, phenyl or 3,3,3-trifluoropropyl radical, at least 80%, by number of the radicals R being methyl radicals; the radicals B, which may be identical or different, are each a radical R or the radical V having the following formula:

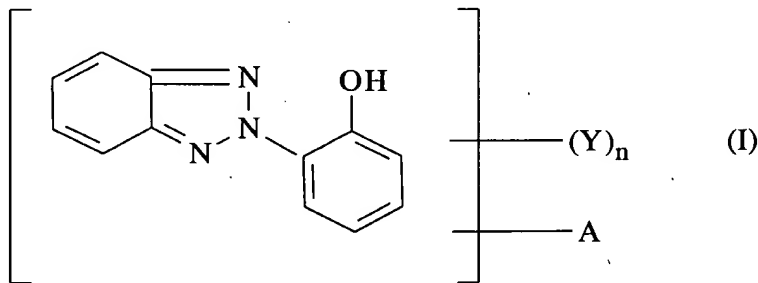


**Attachment to Reply and Amendment Dated**

**Marked-up Claims 2 and 4**

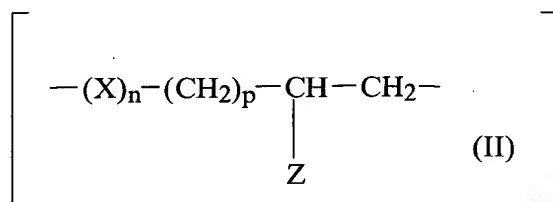
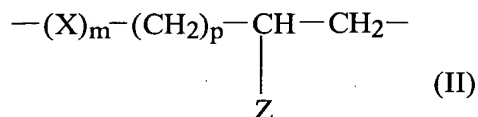
in which Y,  $\underline{n}$  and L are as defined above;  $\underline{r}$  is an integer ranging from 0 to 50, inclusive, and  $\underline{s}$  is an integer ranging from 1 to 20, inclusive, and, if  $\underline{s} = 0$ , then at least one of the two radicals B is a radical V;  $\underline{u}$  is an integer ranging from 1 to 6, inclusive, and  $\underline{t}$  is an integer ranging from 0 to 10, inclusive, with the proviso that  $\underline{t} + \underline{u}$  is greater than or equal to 3, and (b) at least one bis-resorcinyll second sunscreen compound, formulated into (c) a topically applicable, cosmetically acceptable vehicle, diluent or carrier therefor.

4. (Amended) A topically applicable sunscreen/cosmetic composition suited for the photoprotection of human skin and/or hair, comprising an effective SPF-maintaining and water remanence-enhancing amount of combinatory immixture of (a) at least one benzotriazole first sunscreen compound having the structural formula (I):



**Attachment to Reply and Amendment Dated**

**Marked-up Claims 2 and 4**

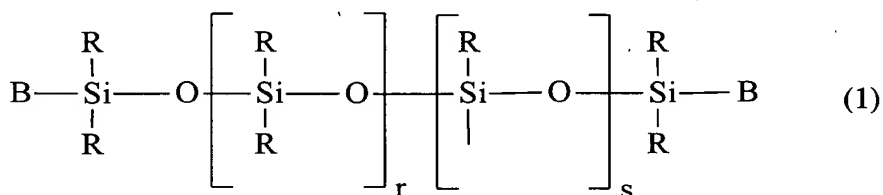


in which A is a hydrogen atom or a divalent radical -L-W-; n is 1, 2, or 3; the radicals Y, which may be identical or different, are each a C<sub>1</sub>-C<sub>10</sub> alkyl radical, a halogen atom, a C<sub>1</sub>-C<sub>10</sub> alkoxy radical or a sulfonic group, with the proviso that, in the latter instance, two adjacent groups Y on the same aromatic nucleus can together form an alkylidenedioxy group in which the alkylidene moiety has 1 or 2 carbon atoms and with the further proviso that the radicals Y are other than a sulfonic group when A is other than a hydrogen atom; L is a divalent radical having the formula (II) below:

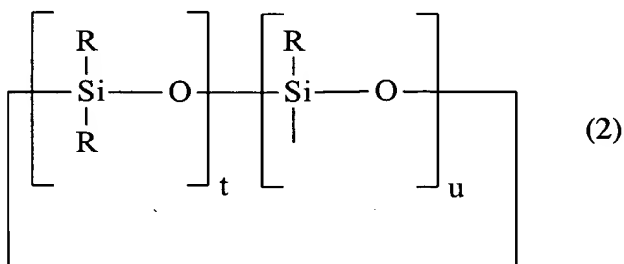
Attachment to Reply and Amendment Dated

**Marked-up Claims 2 and 4**

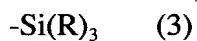
in which X is O or NH; Z is a hydrogen atom or a C<sub>1</sub>-C<sub>4</sub> alkyl radical; n is an integer ranging from 0 to 3, inclusive; m is 0 or 1; p is an integer ranging from 1 to 10, inclusive; W is a radical of formula (1), (2) or (3) below:



or



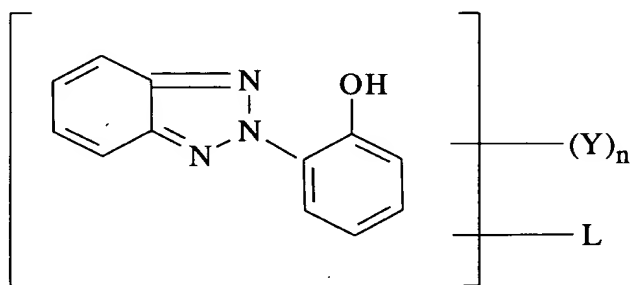
or



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**Marked-up Claims 2 and 4**

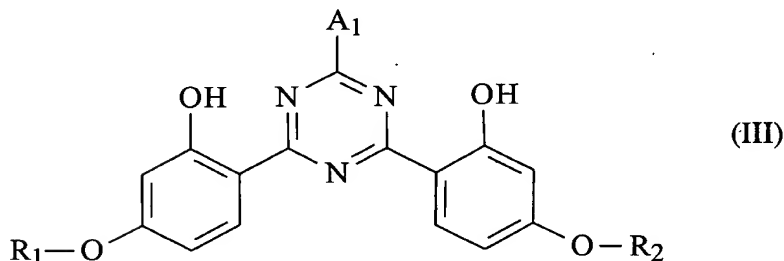
in which the radicals R, which may be identical or different, are each a C<sub>1</sub>-C<sub>10</sub> alkyl, phenyl or 3,3,3-trifluoropropyl radical, at least 80%, by number of the radicals R being methyl radicals; the radicals B, which may be identical or different, are each a radical R or the radical V having the following formula:



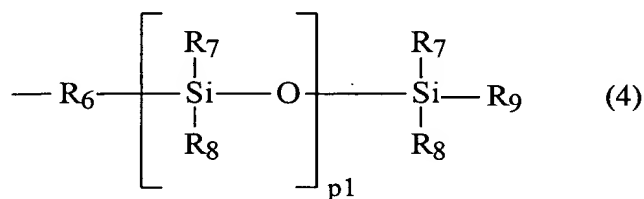
in which Y, n and L are as defined above; t is an integer ranging from 0 to 50, inclusive, and s is an integer ranging from 1 to 20, inclusive, and, if s = 0, then at least one of the two radicals B is a radical V; u is an integer ranging from 1 to 6, inclusive, and t is an integer ranging from 0 to 10, inclusive, with the proviso that t + u is greater than or equal to 3, and (b) at least one bis-resorcinyltriazine second sunscreen compound, having the structural formula (III):

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**Marked-up Claims 2 and 4**



in which (i) the radicals  $R_1$  and  $R_2$ , which may be identical or different, are each a  $C_3$ - $C_{18}$  alkyl radical, a  $C_2$ - $C_{18}$  alkenyl radical, or a residue of formula  $-CH_2-CH(OH)-CH_2-OT_1$  wherein  $T_1$  is a hydrogen atom or a  $C_1$ - $C_8$  alkyl radical; (ii) the radicals  $R_1$  and  $R_2$ , which may be identical or different, can also be a residue of formula (4) below:

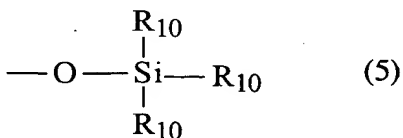


in which  $R_6$  is a covalent bond, a linear or branched  $C_1$ - $C_4$  alkyl radical, or a residue of formula  $-C_{m1}H_{2m1}-$  or  $-C_{m1}H_{2m1}-O-$  wherein  $m_1$  is a number ranging from 1 to 4;  $p_1$  is a number ranging from 0 to 5; the radicals  $R_7$ ,  $R_8$  and  $R_9$ , which may be identical or different, are each a  $C_1$ - $C_{18}$  alkyl radical, a  $C_1$ - $C_{18}$  alkoxy radical, or a residue of formula:

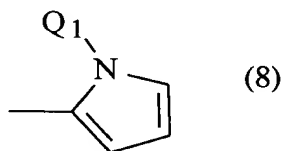
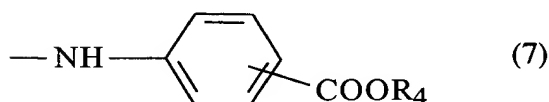
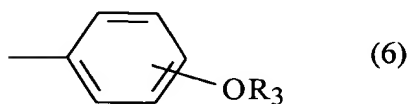


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**Marked-up Claims 2 and 4**



in which R<sub>10</sub> is a C<sub>1</sub>-C<sub>5</sub> alkyl radical; A<sub>1</sub> is a residue having one of the following formulae:



in which R<sub>3</sub> denotes a hydrogen atom, a C<sub>1</sub>-C<sub>10</sub> alkyl radical, a radical of formula -(CH<sub>2</sub>CHR<sub>5</sub>-O)<sub>n<sub>1</sub></sub>R<sub>11</sub> wherein n<sub>1</sub> is a number ranging from 1 to 16, R<sub>11</sub> is a hydrogen atom or methyl radical or a residue of structure -CH<sub>2</sub>-CH(OH)-CH<sub>2</sub>OT<sub>1</sub> wherein T<sub>1</sub> is as defined above; R<sub>4</sub> is a hydrogen atom, a metal cation M, a C<sub>1</sub>-C<sub>5</sub> alkyl radical, or a residue of

**Attachment to Reply and Amendment Dated**

**Marked-up Claims 2 and 4**

formula  $-(CH_2)_{m_2}-OT_1$  wherein  $m_2$  is a number ranging from 1 to 4 and  $T_1$  is as defined above, and  $Q_1$  is a  $C_1-C_{18}$  alkyl radical, formulated into (c) a topically applicable, cosmetically acceptable vehicle, diluent or carrier therefor.